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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JASON A. A. WEST, TIMOTHY J. SHEPODD,
STEWART K. GRIFFITHS, RONALD F. RENZI, and
BOYD J. WIEDENMAN

Appeal 2010-002425
Application 10/701,097
Technology Center 1700

Before CHUNG K. PAK, BEVERLY A. FRANKLIN, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This is in response to a Request, filed April 29, 2011, for rehearing of our Decision, decided March 1, 2011.

Appellants contend that the Decision presents a new ground of rejection because the Board relies on paragraph [0137] of McNeely to counter McNeely's paragraph [0084] teaching that shallow channels cause problems and are difficult to fill (Req. 6). Appellants contend that the

Examiner never relied on this interpretation of McNeely and the Board's reliance on an interpretation that differs from the Examiner's interpretation demonstrates that the Examiner's findings could not sustain the final rejection of the claims (*id.*). Appellants argue that paragraph [0137] of McNeely only teaches that backfilling of the channels "may form a smoother and more uniform interior surface than could be obtained otherwise" (*id.*). Appellants argue that McNeely's paragraph [0137] fails to teach using backfilling to produce chambers having Appellants' claimed depths from 1 to 10 micrometers (*id.* at 6-7).

Contrary to Appellants' arguments, the Board's reliance on McNeely's paragraph [0137] does not constitute a new ground of rejection, as the thrust of the rejection remains the same. *See In re Jung*, 637 F.3d 1356,1365 (Fed. Cir. 2011), *citing In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976). As reasoned by the court in *Kronig*, the thrust of the rejection as reviewed by the Board and the Examiner's rejection are the same because the rejection is still under 35 U.S.C. § 103(a); Mathies is relied upon for its uncontested teachings (Decision 6), Quake is relied upon for its teaching of channel heights in microfluidic devices and McNeely is relied upon to teach a microfluidic chip that utilizes a plurality of microarrays but fails to teach the claimed channel height as stated by the Examiner. *Id.*

Notably, the Examiner cites to and relies on the teachings contained in the entire McNeely reference with regard to the microfluidic chip structure (Ans. 6; Final Office Action 3). Appellants were aware of the Examiner's reliance on the entire McNeely disclosure as of at least the Non-Final Office Action dated October 25, 2007. Therefore, our citation to paragraph [0137]

of McNeely merely highlights a portion of the McNeely disclosure relied upon by the Examiner of which Appellants should have been aware.

Furthermore, as stated on page 5 of the Decision, our citation to McNeely's paragraph [0137] teaching is merely to underscore the Examiner's findings that McNeely's difficulty with using smaller channel heights disclosed in paragraph [0084] are tied to the gasket sealing mechanism (Ans. 25-26). McNeely's paragraph [0137] merely teaches ways (i.e., backfilling of the channel) to overcome the limitations caused by the gasket sealing mechanism and surface roughness of the channel to thereby decrease the channel volume.

Appellants' arguments that McNeely merely teaches controlling surface roughness of the channel by backfilling fail to account for McNeely's full disclosure in paragraph [0137]. Rather, McNeely in paragraph [0137] teaches that backfilling the channel not only provides a smoother surface, it also reduces the volume of the channel. In other words, the channel dimensions, such as height, are reduced to thereby reduce the channel volume. Appellants do not address this teaching of McNeely in their Request.

Appellants rely on *In re De Blauwe*, 736 F.2d 699, 706 n.9 (Fed. Cir. 1984) for the proposition that where the Board advances "a position or rationale new to the proceedings, an applicant must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence" (Req. 9). The facts of *De Blauwe* differ from the facts presented in this appeal because in *De Blauwe* the Board failed to consider evidence of secondary considerations and the PTO did not challenge such evidence until appeal to the Federal Circuit. *De Blauwe*, 736

F.2d at 706. In contrast, the Examiner and Board both considered the full disclosure of the McNeely reference and all the teachings relied upon by the Examiner. Moreover, footnote 9 of *De Blauwe* refers to *In re Eynde*, 480 F.2d 1364 (CCPA 1973) as supporting the proposition that Appellant must be afforded an opportunity to respond to any position or rationale that is new to the proceedings. *Id.*

Eynde concerned a Board decision that advanced an analysis of what a person skilled in the art would have considered to be the state of the art that differed from the examiner's analysis. *Eynde*, 480 F.2d at 1371. In response to the Board's analysis, Appellants submitted evidence in a request for reconsideration that the Board refused to consider. *Id.* The court found this failure to consider the evidence erroneous. *Id.*

Unlike the facts in *Eynde*, the evidence is not new because the Examiner relies on the entire disclosure of McNeely which includes the paragraph [0137] teachings. Additionally, we have considered Appellants' arguments regarding McNeely's paragraph [0137] filed with their Request. Accordingly, Appellants availed themselves of their opportunity to respond to the Board's Decision. However, we find Appellants' arguments unpersuasive.

Appellants further argue that the Board improperly applied the "reversible error" standard of review (Req. 3). Appellants contend that the use of the "reversible error" standard gave undue deference to the Examiner (*id.*). Appellants argue that there is no evidence in the Decision that the Board initially reviewed the Examiner's decision to determine whether the facts were sufficient to establish a prima facie case of obviousness and shift the burden to Appellants to go forward (*id.* at 4).

Contrary to Appellants' arguments, the Federal Circuit has approved of the long time practice of the Board to require an appellant to identify alleged error (i.e., reversible error) in the Examiner's rejections. *Jung*, 637 F.3d at 1365. Moreover, Appellants' mere allegation that the Board did not review the Examiner's decision *de novo* is unpersuasive. Our analysis on pages 4-7 of the Decision reflects that we reviewed the Examiner's rejections in light of the applied prior art in order to determine whether the Examiner had met the initial burden of establishing a *prima facie* case.

Appellants contend that we failed to rely on the full quotation of McNeely's paragraph [0084] disclosure in assessing whether McNeely teaches away from the claimed invention (Req. 5). This argument is hollow because pages 5-6 of the Decision recognize McNeely's teaching that the gasket material limits the size of the microchannel depths, but we disagree with Appellants' characterization of McNeely's teaching as constituting a teaching away for the reasons stated on page 6 of the Decision.

Appellants contend that the Board erred in determining that Appellants' evidence of nonobviousness was unpersuasive because the evidence was not compared to the closest prior art (Req. 7). Appellants argue that § 716.02(b) of the Manual of Patent Examining Procedure (MPEP) does not require Appellants to compare their invention with the closest prior art, but rather art that is commensurate in scope with the claims (*id.*). Appellants contend that they have compared their invention to an existing device that performs the same function and such comparison is entitled to evidentiary weight (*id.*).

However, the Examiner and the Board have given weight to Appellants' evidence of secondary considerations, but we find the evidence

not probative of nonobviousness. Contrary to Appellants' argument that the MPEP § 716.02(b) does not require a comparison of the claimed invention with the closest prior art, § 716.02(b) states:

Evidence of unexpected properties may be in the form of direct or indirect comparison of the claimed invention with *the closest prior art* which is commensurate in scope with the claims. (citations omitted) (emphasis added).

Accordingly, the requisite comparison is between the claimed invention and the closest prior art commensurate in scope with the claimed invention. As stated on page 8 of the Decision, the closest prior art according to Appellants is the McNeely reference (Dec. 8). Therefore, the proper comparison is between McNeely's device and the device of the claimed invention.

Appellants contend that an indirect comparison has been made with the McNeely reference, which must be considered (Req. 8). We have considered this indirect comparison; however, the West Declaration does not indicate that the "existing alternative product" used in the comparison is in any way structurally similar to McNeely's device. As the Examiner stated, even though McNeely teaches leaving the sample "overnight," it is not clear that McNeely's device does not achieve the level of hybridization within a shorter period of time (Ans. 28-29). Therefore the indirect comparison is inconclusive with regard to any showing related to McNeely's device. We adhere to our determination that Appellants' evidence is not probative of nonobviousness as stated on page 8 of the Decision.

For the above reasons, the Request for Rehearing is denied.

DENIED

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